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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/725,938	12/03/2003	Holger Hoppe	543822002400	4491
25227	7590	08/30/2005		
MORRISON & FOERSTER LLP 1650 TYSONS BOULEVARD SUITE 300 MCLEAN, VA 22102			EXAMINER KOBERT, RUSSELL MARC	
			ART UNIT	PAPER NUMBER
			2829	

DATE MAILED: 08/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

AKC

**Office Action Summary**

Application No.

10/725,938

Applicant(s)

HOPPE, HOLGER

Examiner

Russell M. Kobert

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 June 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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1. Applicant's arguments with respect to claims 1-14 have been considered but are moot in view of the new ground(s) of rejection.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

1. Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohba (6323666).

Ohba describes a testing method for testing contacting between a semiconductor device and a carrier, comprising loading the carrier with the semiconductor device, such that contacting between the carrier and the semiconductor device is tested immediately

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after the loading of the carrier with the semiconductor device (col 4, ln 38-47, 63-67); as recited in claim 1.

As to claim 2, connecting the carrier to a testing apparatus is anticipated by Ohba (col 2, ln 6-10).

As to claim 3, having the carrier is connected to the testing apparatus and the carrier subsequently loaded with the semiconductor device is considered an inherent function within the operable scope of Ohba.

As to claim 4, Ohba anticipates the carrier being loaded at a carrier loading station and contacting between the carrier and the semiconductor device is tested before the carrier is transported to a further station (see SUMMARY OF THE INVENTION).

As to claim 5, having the contacting between the carrier and the semiconductor device tested by the testing apparatus is considered an inherent function within the operable scope of Ohba.

As to claim 6, the testing apparatus being configured such that it tests the contacting between the carrier and the semiconductor device without functioning of the semiconductor device is considered an inherent function within the operable scope of Ohba (col 3, ln 6-10).

As to claim 7, performing the contacting between the carrier and the semiconductor device being tested within 2 seconds after loading of the carrier with the semiconductor device is considered an inherent function within the operable ranges of Ohba.

Moreover, the limitations of claims 8-11 are considered inherent in the apparatus of Ohba and within the normal range of operating the apparatus of Ohba.

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As to claim 12, Ohba describes a testing system for testing contacting between a semiconductor device and a carrier, comprising a testing apparatus to which a carrier can be connected, and which is configured such that contacting between the carrier and the semiconductor device is tested by the testing device immediately after loading of the carrier with a semiconductor device (col 4, ln 38-47, 63-67).

As to claim 13, having the test apparatus performing the test after a signal is output by a loading device, the signal indicating that the carrier was loaded with the semiconductor device is considered an inherent part of the operation of Ohba (col 4, ln 19-42).

As to claim 14, the test system further comprising a testing apparatus, the testing apparatus being configured such that contacting between the carrier and the semiconductor device is tested immediately after loading of the carrier with the semiconductor device is anticipated by Ohba (col 4, ln 38-47, 63-67).

Although Ohba does not specifically describe the semiconductor device comprises one or more contacts for testing the contacting between the semiconductor device and the carrier as now stated in claims 1 and 12, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have recognized that semiconductor devices include Integrated Circuit chips and it is well established in the art that such Integrated Circuit chips contain a plurality contacts regardless of what application such integrated circuits and their associated contacts are utilized for.

2. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Russell Kobert whose telephone number is (571) 272-1963.

The Examiner's Supervisor, Nestor R. Ramirez, can be reached at (571) 272-2034.

For an automated menu of Tech Center 2800 phone numbers call (571) 272-2800.



Russell M. Kobert  
Patent Examiner  
Group Art Unit 2829  
August 22, 2005



VINH NGUYEN  
PRIMARY EXAMINER  
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08/25/05